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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,113	11/05/1999	MAX P. MCDANIEL	33815US	4779
35395	7590	03/04/2004	EXAMINER	
JOHN S. PRATT KILPATRICK STOCKTON LLP (CHEVRON) 1100 PEACHTREE STREET ATLANTA, GA 30309			PASTERCZYK, JAMES W	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/435,113	<b>Applicant(s)</b> MCDANIEL ET AL.	
	<b>Examiner</b> J. Pasterczyk	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12/12/03, 1/15/04 and 1/26/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-47,61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-47,61 and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/15/04</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|--|---|

1. This Office action is in response to the papers filed 12/12/03, 1/15/04 and 1/26/04 and refers to the Office action mailed 9/9/03.

2. Claims 30-47, 61 and 62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Addition of the negative limitation "non-fluorinated" to all the independent claims does not appear to be affirmatively, explicitly supported in the specification as originally filed. In fact, the examiner has not found any mention of the constituents of the catalyst other than the required ingredients of chromium, titanium, and silica, although p. 5, l. 15-16 discloses that other ingredients are positively allowed in the support. The examples pointed to by applicants in their last amendment are likewise silent on the absence or presence of fluoride. The entire specification is utterly silent as to the criticality of the presence or absence of any halogen in the catalyst.

Applicants cite various cases to support their contention that this negative limitation is not new matter. However, none of the cases cited appears to be on point. *In re Johnson*, 194 USPQ 187 (CCPA 1977), deals with a case that had been through an interference proceeding which appeared to delete subject matter from the claims by removal of members of a disclosed Markush group; the species deleted from the claims were specifically disclosed, not merely omitted. In *In re Driscoll*, 195 USPQ 434 (CCPA 1977), in a fact-intensive analysis, the court held that a specific Markush group of substituents on a particular position of a heterocyclic ring

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compound of an earlier ancestor case was sufficient basis for disclosure of a subgenus of that heterocyclic compound with essentially any substituent group at the same position on the ring in a subsequent offspring case, thus satisfying the 35 USC 112, first paragraph description requirement. In addition, the court in dicta stated that "... each case must be decided on its own facts. Thus the precedential value of cases in this area is extremely limited." The court thus recognized the fact-intensive nature of analysis of cases of this type. *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111 (CAFC 1991) is not on point since it deals with a design patent rather than a utility patent as is presently under consideration. Nevertheless, the court therein held that the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Vas-Cath* also appears to have some negative history associated with it, hence it may not be good law on the point applicants are presently arguing. *Crown Operations Int'l v. Solutia Inc.*, 62 USPQ2d 1917 (CAFC 2002) came to the court in the posture of a request for summary judgment stating that a patent was invalid. Therein, the court held that although in haec verba support in a patent specification is not necessary to provide support for a claim limitation, one skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims, and that a limitation that would have been inherently present as viewed by such a person is sufficiently disclosed to meet the requirement of 35 USC 112, first paragraph. In *Ex parte Parks*, 30 USPQ2d 1234 (Bd. App. 1994), the Board stated that lack of literal support for the absence of a particular ingredient in a chemical case does not, in and of itself, establish a prima facie case for lack of adequate written description under 35 USC 112, first paragraph. However, the Board also noted approvingly therein *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). In *Grasselli*, a negative

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limitation was added to a composition claim to overcome a prior art rejection. Lack of any support for this new negative limitation was held to be new matter, and thus the claims were properly rejected. The Board furthermore stated in *Parks* that "... it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst", the absence of the catalyst being the new limitation added to the claims to overcome a prior art rejection. In the present case, throughout the discussion of the catalyst which would seem to cry out for the absence of fluoride if the absence of any halide were critical, no mention is made of this feature. It thus appears that *Grasselli* is the closest case on point to the present facts, and hence is properly controlling. Finally, since the present claims are recited in open "comprising" Markush language with respect to the ingredients of the catalyst, the presence of additional ingredients is not barred; fluoride would thus not be barred absent the new matter limitation.

3. Claims 30-47, 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, first line of b), insert "--the group consisting of--" after "selected from" for clearly consistent closed Markush language; in the last line, change "or" to "--and--" before "iii" and "mixtures thereof"; in the penultimate line insert "--the group consisting of--" after "from".

In claim 46, first line of b), insert "--the group consisting of--" after "selected from"; in the last line of b) change "or mixtures thereof; or" to "--and mixtures thereof; and--"; in the line

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preceding insert --the group consisting of-- after "consisting of". In 2), after "selected from" insert --the group consisting of-- and change "or" before "zirconium" to --and--.

In claim 61, part b), after each instance of "selected from" insert --the group consisting of--; in the last line of that section change "or mixtures thereof; or" to --and mixtures thereof; and--.

In claim 62, part b), after each instance of "selected from" insert --the group consisting of--; in the last line of that section change "or mixtures thereof; or" to --and mixtures thereof; and--.

In claim 37, "active chromium catalyst component" lacks antecedent basis, and it is not clear what atoms in this component are to be counted toward the ratio.

In claim 39, after "selected from" insert --the group consisting of--, and change "or mixtures thereof" to --and mixtures thereof--.

In claim 47, after "organoaluminum" insert --compound--.

4. Applicant's arguments with respect to claims 30-47, 61 and 62 have been considered but are moot in view of the new ground(s) of rejection.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 30-47, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel et al., USP 4,735,931 (hereafter referred to as McDaniel) in view of Debras, Witt and Konrad as previously cited.

McDaniel discloses a catalyst composition substantially reading on the present invention including one combination of cocatalysts presently claimed (abstract; col. 1, l. 58 to col. 2, l. 45).

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McDaniel lacks disclosure of the other combinations of cocatalysts of the present claims as well as the pore volume and surface area of the catalyst.

However, Witt teaches that it is conventional with chromium catalysts to use alkyl boron compounds and alkyl aluminum alkoxides as cocatalysts (col. 2, l. 30 to col. 3, l. 25), and Konrad teaches that lithium alkyls and alkyl aluminum dialkoxides are conventional cocatalysts with chromium catalysts (col. 2, l. 32; col. 7, l. 26). Debras teaches that in chromium catalysts it is conventional to use supports with surface areas and pore volumes reading on the present invention (col. 2, l. 60-63).

It would have been obvious to one of ordinary skill in the art to apply the teachings of Debras, Konrad and Witt to the disclosure of McDaniel with a reasonable expectation of obtaining a highly-useful chromium catalyst with the expected benefit of greater regulation of molecular weight of the polymer produced by addition of hydrogen to the polymerization mixture.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pasterczyk

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